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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,050	01/25/2006	Ji-Hyun Kim	Q90861	8300

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EXAMINER	
VAKILI, ZOHREH	
ART UNIT	PAPER NUMBER
1614	

NOTIFICATION DATE	DELIVERY MODE
02/25/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/554,050	KIM ET AL.	
	Examiner	Art Unit	
	ZOHREH VAKILI	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 November 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) *1-5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/11/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-6 are presented for examination.

A request for continued examination under 37 C.F.R. 1.114, including the fee set forth in 37 C.F.R. 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. 1.114, and the fee set forth in 37 C.F.R. 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 C.F.R. 1.114. Applicant's submission filed November 12, 2009 has been received and entered into the present application. Claims 1-5 are withdrawn from consideration. Claim 6 is pending and is herein examined on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: 1. Determining the

scope and contents of the prior art. 2. Ascertaining the differences between the prior art and the claims at issue. 3. Resolving the level of ordinary skill in the pertinent art. 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pugliese (US Pat. No. 6596289 B1), in view of Tadashi Hase et al., Anti-Obesity Effects of Tea Catechins in Humans, 2001, Jornal of Oleo Science, No. 7, Vol. 50, Pg. 599, further in view of JP10234968 and JP 2000-229827 with Max (US Pat. No. 6638545).

Pugliese teaches an effective treatment that has been devised for cellulite that consists of the following ingredients that may be applied topically, either in a cream, lotion, or gel. The ingredients may be affixed to a garment, such as panty hose or a stocking, in micro-encapsulated form; or they may be applied as a material patch, or plaster, either in a gel form or cloth supported form (see paragraph 0022). The method of treating cellulitis in women wherein the application formulation comprises an

oil-in-water emulsion comprising: (a) an oil-soluble hydroxyflavone selected from the group consisted of quercetin and fifecetin; (b) an oil-soluble isoflavone selected from the group consisting of **genistein**, diadzein, and biochanin-A; (c) an oil-soluble amino substitute butanoate selected from the group consisting of DL-carnitine, **L-carnitine**, and carnitine acetate; (d) a water-soluble xanthine selected from the group consisting of theophylline, theophylline salts, **caffeine**, and theopromine; (e) a water-soluble plant extract coleus forskohlii; (f) a solubizing agent for the oil-soluble ingredients; and, (g) an emulsifying agent for mixing the oil phase with the aqueous phase (see claim 8). The oil-in-water emulsion of claim 1 wherein the isoflavone is **genistein** and is present in the weight volume of up to about 5% (see claim 4). The oil-in-water emulsion of claim 1 wherein the xanthine is theophylline acetate and is present in the weight volume of up to about 4% (see claim 5). The oil-in-water emulsion of claim 1 wherein the butanoate is L-acetyl carnitine and is present in the weight volume of up to about 1.5% (see claim 7).

Hase et al. teach the anti-obesity effects of tea catechins in humans, a trial study using healthy male subjects (27-47 years). Comprising in equal number a low dose catechin (LDC) group (n=11) and high dose catechin (HDC) group (n=12). The groups were administered catechins at 118.5 mg and 483.0 mg a day for 12 weeks, respectively. At 4 and 12 weeks, effect evaluation was made based on change in weight, body mass index (BMI), waist circumference, body fat ratio and abdominal fat as determined by computed tomography (CT) and triacylglycerol, total cholesterol, free fatty acid, glucose, insulin and total plasminogen activator inhibitor-1 (PAI-1) in serum.

In the HDC group, at 12 weeks, weight, BMI, waist circumference, body fat ratio, abdominal fat and total cholesterol, glucose, insulin, PAI-1 in serum were noted to have significantly decreased from values at 0 week. Tea catechins are thus shown here for the first time to have the anti-obesity effects in humans (see abstract).

JP10234968 teaches an anti-obesity composition comprises theanine. Theanine used in the anti-obesity composition of this invention is not particularly restricted. Theanine contained in tea leaves being the main component of tea flavor is known and its content is higher than those of other amino acids. A method for producing theanine used in the invention is not particularly restricted. The content of the theanine in the composition of the present invention may be appropriately adjusted depending upon the concrete symptoms, ages, number of administration, and the like. For example, the content of the theanine in the composition is preferably from 0.00025 to 100% by weight, more preferably 0.005 to 100% by weight (see abstract)

JP 2000-229827 teaches the skin external preparation further comprises medicinal components catechin and its derivative, xanthin and their derivatives, theophylline, caffeine, and theanine. Preferred Composition: The skin external preparation contains 0.0005-5 weight percent of the components. The skin external formulated as lotion, cream, ointment etc. (see abstract). This teaching is used to indicate that catechin and theanine along with caffeine can be used in formulations for external use applied on the skin as lotion or ointment.

Max teaches a method for the treatment of cellulite, obesity or excess weight

(see claim 1). This teaching is used to combine the treatment of obesity and cellulite. As evidenced by Max once obesity is treated cellulite is also treated. Cellulite is accumulation of layers of fat.

Clearly, the skilled artisan is provided with ample instruction and motivation to use theanine, genisteine, L-carnitine, catechin and caffeine to produce a composition that has slimming effect. The skilled artisan is motivated to make compositions of the well known ingredients for medicinal and cosmetic uses, most notably for their anti-suppressant properties to offset the losing of weight by those who are in need of such a composition. The prior arts teach of the same component and its concentration that is instantly claimed. Accordingly, it is well settled that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In other words, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. See In reBest, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

In re Kerkhoven (205 USPQ 1069, CCPA 1980) states that "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same purpose: the idea of combining them flows logically from their having been individually taught in the prior."

One of ordinary skill in the art would have been motivated to combine the above references and as combined teach and suggest the invention as claimed. Thus the claimed invention was within the ordinary skill in the art to make and use at the time the claimed invention was made and was as a whole, *prima facie* obvious.

Applicant's remarks and amendments have been fully and carefully considered in their entirety, but fail to be persuasive.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Vakili whose telephone number is 571-272-3099. The examiner can normally be reached on 8:30-5:00 Mon.-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Zohreh Vakili

Patent Examiner January 17, 2010
1614
/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614